

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/495,105
Filing Date: February 1, 2000
Applicant: Graham B. McCloy et al.
Group Art Unit: 2875
Examiner: Thomas M. Sember
Title: EXTERIOR REAR VIEW MIRROR HAVING A CHIN STRAP AND A REPEATER
Attorney Docket: SCH-00026

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.181(a) TO WITHDRAW THE HOLDING OF
ABANDONMENT AND A PROVISIONAL PETITION TO REVIVE
UNDER 37 CFR 1.137 (b) AND A REQUEST FOR RE-ENTRY OF THE
PREVIOUSLY FILED CONTINUATION APPLICATION**

Sir:

Pursuant to 37 CFR 1.181(a), this is a petition to withdraw the holding of Abandonment that was issued in the above-referenced patent application. This is also a Provisional Petition to Revive under 37 CFR 1.137(b) in the event that the Petition to Withdraw the Holding of Abandonment is denied. Additionally, this is a request for re-entry of the previously filed continuation application. Both petitions are being filed in a timely manner in accordance with 37 CFR 1.181(f), which provides that the petition must be filed within two months of the document from which review is sought. Therefore, since the Notice of Abandonment was mailed on December 15, 2003 a

timely filed Petition to Withdraw the Holding of Abandonment or Petition to Revive under 37 CFR 1.137(b) would be on or before February 15, 2004.

I. Petition to Withdraw the Holding of Abandonment

MPEP 711.03(c), paragraph I, states “[w]here an applicant contends that the application is not in fact abandoned...a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee.” Additionally, it should be noted that a petition under 1.181(a) does not have a reply requirement. See MPEP 711.03(c), paragraph III(A). However, Applicant wishes to submit a Request for Continued Examination (RCE) which contains a resubmitted version of the original Amendment in Response to Decision on Appeal. This Amendment obviates the Examiner’s objections to claims 33 and 34, thus putting them in allowable format. The RCE has been attached with this Petition and Applicant respectfully requests entry thereof upon grant of the Petition to Withdraw the Holding of Abandonment.

A. Background of this Petition

The facts pertinent to this petition are set forth as follows:

1. On October 31, 2001 a Notice of Appeal was filed and Applicant’s Appeal Brief was submitted on February 28, 2002. The appeal concerned the Examiner’s rejection of claims 25-34 and 41-59 of the application.

2. On May 22, 2002 the Examiner’s answer was submitted. In the Examiner’s answer it was indicated that the Examiner withdrew the rejection of claims 33 and 34

stating that they were only objected to as being dependent upon a rejected base claim and would be allowable if rewritten in independent form. See the Examiners Answer page 14.

3. On August 27, 2003 the Board of Appeals issued its decision. The decision affirmed the rejection of claims 25-32 and 41-59, and acknowledged the Examiner's withdrawal of the rejection of claims 33 and 34.

4. On October 24, 2003 Applicant filed an Amendment in Response to Decision on Appeal, which was drafted to overcome the Examiners objections to claims 33 and 34 by amending the existing claim 25 to include all the allowable subject matter indicated in claim 33, and adding claim 60 which included the allowable subject matter of claim 34.

5. On December 15, 2003 a Notice of Abandonment was mailed.

6. On several occasions between December 19, 2003 and December 29, 2003 Applicant's representative contacted the Examiner regarding the Notice of Abandonment to inquire why the previous Amendment was not entered. The substance of the reasoning for the holding of Abandonment is discussed in The Decision Below section of this opinion.

B. The Decision Below

The Examiner indicated that the Amendment was improperly submitted after the Board's decision. Therefore, such an Amendment cannot be entered. It was the

Examiner's reasoning that at the time of the issuance of the Board's decision affirming the Examiner's rejection, the prosecution of the application was then closed. Therefore, Applicant should have submitted the Amendment prior to the Board's decision. The Examiner indicated that he had discussed the matter with his supervisory patent examiner (SPE) and felt that this was the correct procedure, therefore, the case would remain abandoned.

Applicant wishes to note that to his knowledge no communication oral or written was given to the Applicant's representative indicating that the case would be abandoned or that the Amendment was improper.

C. Discussion of the Applicable Law

MPEP 1214.06 paragraph I addresses the handling of an application in which no claims stand allowed after the Board's decision. Unfortunately the MPEP does not explain the procedure when the Examiner's Answer withdraws the rejection of some of the dependent claims and then is subsequently affirmed with respect to the claims that remain on appeal.

This section states in part:

[t]he proceedings in an application ... are terminated as of the date of the expiration of the time for filing of a court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to the abandoned files... [c]laims indicated as allowable **prior to appeal** except for their dependency from rejected claims will be treated as if they were rejected. [emphasis added].

MPEP 1214.06 paragraph I appears to be what the Examiner relied on for his decision to hold the case abandoned. However, the language of MPEP 1214.06 paragraph I referenced above specifically states that the objected to claims had to been indicated as being allowable except for their dependency **prior to appeal**. Clearly the Examiner's

Answer that withdrew the rejection of claims 33 and 34 was after appeal. Therefore this part of MPEP 1214.06, paragraph I cannot be controlling by virtue of this limitation.

MPEP 1214.06 paragraph I also states in part:

(B) if the Board or Court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, the Examiner after expiration of the period for further appeal, should proceed in one of two ways:

(1) convert the dependant claim into independent form by Examiner's Amendment, cancel all claims in which the rejection was affirmed, and issue the application; or

(2) set a one-month time limit in which the appellant may rewrite the dependent claim in independent form...

Because the rejection of claims 33 and 34 was withdrawn after Applicant filed their Appeal Brief, and not prior to appeal, the rejection of these claims was effectively reversed by the board. Applicant asserts that this part of MPEP 1214.06 paragraph I would therefore more appropriately control in light of the facts herein. Thus, the Examiner, after the Board's decision, was under an obligation to either convert the objected to dependent claims to an independent claim by Examiner's Amendment, or should have set a one-month time-limit for the Applicant to re-write the dependent claims in independent form. However, the Examiner failed to comply and instead held the case abandoned.

Applicant also requests that this petition be granted based on the fact that the proceedings in this case were not terminated. 37 CFR 1.197(c) states:

Proceedings are considered terminated by the dismissal of an Appeal or failure to timely file an Appeal to the court or a civil action (§ 1.304) except: (1) Where claims stand allowed in the application or (2) **Where the nature of the decision requires further action by the Examiner.** [emphasis added].

Page 14 of the Examiner's Answer indicated that the rejection of dependent claims 33 and 34 was withdrawn and would be allowable if these claims were rewritten in independent form to include all of the limitations of the claims from which they depend. Clearly, this situation comes within the second exception mentioned in 37 CFR 1.197(c). The nature of the decision by the Board of Appeals would require further action by the Examiner since the decision was not dispositive of claims 33 and 34 which were indicated to be allowable if rewritten in independent form.

Lastly, MPEP 1207 requires that an Examiner respond to all non-entered Amendments after final rejection. In the present case, an Amendment was submitted after the Board's decision, which is also after a final rejection. According to MPEP 1207, the Examiner should have responded to the non-entered Amendment. As stated above no communications either oral or written regarding the non-entry of the Amendment was received by Applicant prior to the Notice of Abandonment. For all of the above reasons Applicant respectfully requests that this petition be GRANTED.

D. Summary

In summary, Applicant bases this petition to withdraw the Holding of Abandonment of the above-referenced application on three reasons. First, the Examiner should have either converted the dependent claims that were not rejected to independent claims by Examiner's Amendment or give the Applicant a one month time period to rewrite the dependent claims in independent form because dependent claims 33 and 34 were objected to after appeal.

Second, under 37 CFR 1.197(c) the proceedings in this case would not have been considered terminated upon issuance of the Appeal Boards decision since the nature of the decision required further action by the Examiner.

Lastly, the Examiner failed to respond to the non-entered Amendment as required by MPEP 1207. Therefore, it is respectfully requested that this petition for withdraw of abandonment be **GRANTED**.

II. Petition to Revive for Unintentional Abandonment under 37 CFR 1.137(b) and Request for Continued Examination under 37 CFR 1.114

Applicant respectfully submits a Provisional Petition under 37 CFR 1.137(b) to Revive for Unintentional Abandonment in the event that the Commissioner does not grant the Petition to Withdraw the Holding of Abandonment. 37 CFR 1.137(c) states that a grantable petition under this section should be accompanied by a response to the required outstanding Office Action, the petition fee set forth in section 1.17(m), a statement, and a terminal disclaimer.

Applicant submits that the case became abandoned after a Board decision affirming the Examiners rejection of claims 25-32 and 41-59. The status of claims 33 and 34 was changed in the Examiner's Answer from being rejected to being objected to, but allowable if re-written in independent form. Upon the grant of the Petition to Revive under 37 CFR 1.137(b), Applicant wishes to submit a Request for Continued Examination (RCE) which contains a resubmitted version of the original Amendment in Response to Decision on Appeal. This Amendment obviates the Examiner's objections to claims 33 and 34, thus putting them in allowable format. The RCE is attached with this Petition and Applicant respectfully requests entry thereof upon grant of the Petition to Withdraw the Holding of Abandonment.

Applicant hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Since a terminal disclaimer is not required for the Petition to Withdraw the Holding of Abandonment, Applicant has not at this time included a terminal disclaimer. However, if the Petition to Withdraw the Holding of Abandonment is denied and the Petition to Revive for Unintentional Abandonment is granted, then Applicant will submit a terminal disclaimer. Applicant respectfully submits that the requirements of 37 CFR 1.137(b) has been satisfied and hereby requests that this petition for revival of the above-referenced abandoned application be **GRANTED** and the submitted Amendment be entered.

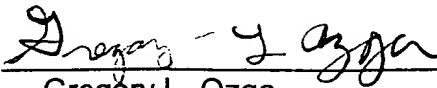
III. Request for Re-Entry of the Continuation Application

A continuation application was filed for the above-referenced application on October 27, 2003. The continuation was filed after the Board's decision, but prior to the commencement of termination proceedings under 37 CFR 1.197. In other words, the continuation was filed within two months of the Board's decision, thus making it prior to commencement of termination proceedings. MPEP 201.11, paragraph 2 states that one of the requirements for filing a continuation is the co-pendency with the earlier filed application. More specifically, the MPEP states "co-pendency is defined in the clause which requires that * > later-filed < application must be filed before (1) the patenting, or (2) the abandonment of, or (3) the **termination of proceedings** in the * > prior < application." MPEP 201.11, paragraph II [emphasis added]. Since the continuation was filed in a timely manner, Applicant requests confirmation that the previously filed continuation has been entered, and if not, Applicant requests re-entry of the continuation since clearly the continuation was filed in a timely manner during the pendency of the application (i.e., prior to the termination proceedings discussed above).

The Commissioner is invited to telephone the Applicant's undersigned attorney at
(248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

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